REMARKS

I. Preliminary Remarks

Minor modifications have been made to the specification. Claims 51-61 have been amended. Claim 50 has been canceled. Claims 62-71 have been added. Claims 44-49 and 51-71 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes with appreciation that the Examiner identified a typographical error in the claim numbering, and made the appropriate corrections to the claim numbers and dependencies. The listing of claims above, and the discussion below, reflect these corrections.

The provisional double patenting rejection based on claims 115-147 of U.S. application Serial No. 09/870,288 ("the '288 application") is also noted. As claims 115-147 of the '288 application have since been canceled, applicant respectfully submits that the provisional double patenting rejection has been rendered moot.

Finally, the previously presented ***Request to Provoke Interference is hereby withdrawn*** for reasons unrelated to the merits of the Request. To that end, previously presented independent claim 50 has been canceled and dependent claims 51-61 have been amended so as to depend from independent claim 44.

II. Rejection Under 35 U.S.C. § 112 (1)

A. The Rejection

Claims 51, 56 and 58-61 have been rejected under 35 U.S.C. § 112, first paragraph, as purportedly failing to comply with the enablement requirement. As independent claim 50 has been canceled and claims 51, 56 and 58-61 have been amended so as to depend from independent claim 44, applicant respectfully submits that the rejection under 35 U.S.C. § 112, first paragraph, has been rendered moot.

Nevertheless, to the extent that current claims 51, 56 and 58-61 may raise similar issues, claims 51, 56 and 58-61 are discussed below.

B. Discussion Concerning Claim 51

The rejection of claim 51 appeared to be based on the Office Action's assertion that the present "application specification ... makes no specific mention of locating an arrhythmia origin in the pulmonary vein [and] then taking steps to isolation that origin." [Office Action at page 3.] Notwithstanding the issue of whether or not this assertion is accurate, claim 51 does not call for the step of "***locating*** an arrhythmia origin in the pulmonary vein." Rather, claim 51 merely indicates "a left atrial arrhythmia originates at least in part from an arrhythmogenic origin located along the pulmonary vein." Thus, one of skill in the art would understand that the "located" portion of claim 51 simply acknowledges the presence of a naturally occurring condition that exists in some human beings. One of skill in the art would further understand that the circumferential lesions around the pulmonary veins described on page 16, lines 32-34 of the present application would necessarily be between an arrhythmogenic origin within a pulmonary vein and the left atrium, and would isolate the left atrium from the arrhythmogenic origin. Thus, one of skill in the art would have been able to practice the method defined by claim 51.

C. Discussion Concerning Claim 56

Claim 56 now depends from claim 44 and adds a step to the method recited in claim 44. One example of a device for creating circumferential lesions in the manner recited in claim 44 is the ablating element 42(6), which is illustrated in Figure 13 and referred to in specification as one of the "Category 1 Curvilinear Ablating Elements." [Page 24, lines 26-28.] Claim 56 calls for the additional step of "ablating an elongate region of tissue located along a left atrial wall of the left atrium with a linear lesion ablation element provided along a linear lesion ablation member." One example of a

device for creating linear lesions in the left atrium is the linear ablating element 176(1), which is illustrated in Figures 27 and 28 and referred to in specification as one of the "Category 2 Curvilinear Ablating Elements." [Page 50, lines 21-26; and page 52, lines 18-35.]

With respect to the issue of whether or not the specification supports the combination of the steps recited in claim 44 and the additional step recited in claim 56, the specification clearly indicates that linear ablating elements 176 may "be used with a Category 1 Element to 'touch up' or perfect incomplete lesions patterns formed by the Category 1 Element." [Page 53, lines 14-17.] The lesion patterns formed by "Category 1" ablating element 42(6) include those lesion patterns which consist of, *inter alia*, circumferential lesions around the pulmonary veins. [Page 46, lines 26-30.] As such, the present application clearly supports the circumferential/elongate lesion combination recited in claim 56.

D. Discussion Concerning Claim 58-61

The Office Action has taken the position that the present application does not provide sufficient information to enable one of skill in the art to ablate a circumferential region of tissue with a cryogenic ablation element, a fluid delivery ablation element, a microwave ablation element, and an optical ablation element. More specifically, the Office Action has taken the position that one of skill in the art would not have been able to add the cryogenic, fluid delivery, microwave, and optical ablation elements that are referred to on page 18 of the present application to the device illustrated in Figure 13.

Notwithstanding the issue of whether or not this position is accurate, applicant respectfully notes that the present claims are ***method*** claims. Thus, to be enabling, the present specification need only describe the method steps in enough detail to allow one of skill in the art to practice the methods with the device illustrated in Figure 13, or any other devices available at the time of the invention that one of skill in the art could use and, if necessary, modify to perform the steps taught by the present application.

III. Newly Presented Claims 62-71

Newly presented independent claim 62 calls for a combination of steps comprising "positioning a tissue ablation device adjacent to a circumferential region of tissue associated with an orifice of a vein that carries blood from the body or lungs to an atrium" and "forming a circumferential conduction block in the circumferential region of tissue with the tissue ablation device." Applicant respectfully submits that the prior art of record fails to teach or suggest such a combination and that claims 62-71 are patentable thereover.

IV. Closing Remarks

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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